AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
Page 5
Serial Number: 09/821,504
Dkt: 2043.199US1
Filing Date: March 28, 2001
Title: GRAPHICAL USER INTERFACE FOR FILTERING A POPULATION OF OPTIONS

REMARKS

This responds to the Final Office Action mailed on February 14, 2005.

No claims have been amended, canceled or added. As a result, claims 1-17 are now pending in this application.

§102 Rejection of the Claims

Claims 1-4, 7, 10-15 and 17 were rejected under 35 USC § 102(b) as being anticipated by Ono et al. (U.S. 5,668,966). The applicant respectfully traverses this rejection.

The '966 patent discloses a system and method for direct manipulation of search predicates using a graphical user interface. Specifically, a graphical user interface allows a *user to set* a predicate which retrieves only desired objects from a database, which stores and manages a number of objects, and filters and reads those objects. (Col. 1, lines 11-17). The '966 patent makes no mention of permanently storing the predicate so that another user could use that same predicate in the future.

The embodiment of the invention as recited in claim 1 includes defining a "library of available criteria to be used in filtering a population," wherein at "least one of the criteria [is applied as a filter]." A "selected criterion" is associated with a "tier of the filter" and a "list of items satisfying a current set of criteria defining the filter" is identified. As a final step, a "graphical representation of the filter" is displayed while the filter is constructed.

The Final Office Action states that the '966 patent defines a library of available criteria by the initial creation of predicates. The Applicant respectfully disagrees with this contention and points out that the '966 patent does not define a library of available criteria. The Final Office Action has failed to cite to a section of the '966 patent where a library is taught. The Applicant respectfully submits that the '966 patent teaches a system in which a user uses a predicate creation system to create predicates, not a system in which a library of available criteria is defined. There is a patentable distinction between the '966 patent's system which requires a user to create predicates and the Applicant's invention in which available criteria are defined in a library.

The Final Office Action of February 14, 2005 responds to the Applicant's argument that a library is a pre-compiled collection. Specifically, the Office Action states that in the '966

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
Serial Number: 09/821,504
Filing Date: March 28, 2001
Title: GRAPHICAL USER INTERFACE FOR FILTERING A POPULATION OF OPTIONS

Page 6
Dkt: 2043.199US1

patent "a degree of compilation" has taken place prior to their (*i.e.,* predicates) being held 'so that a program can use' them." The Applicant again respectfully disagrees, and respectfully submits that there is nothing "prior to" or "pre-compiled" about a user defining predicates in real time.

The Office Action further states, in reply to the Applicant's contention that the term "library" connotes to one of ordinary skill in the art a standard and relatively permanent collection, that the Microsoft Press Computer Dictionary defines a library as the following: "In programming, a collection of routines stored in a file." The Applicant respectfully submits that this definition supports the Applicant's contention that a library is relatively permanent in nature. For all non-trivial programs are permanently stored on some type of non-volatile memory, and retrieved from that memory when execution is required. Consequently, the Microsoft definition of a library as it relates to programming requires a form of relatively permanent non-volatile storage, and supports the Applicant's definition of a library as a relatively permanent collection.

Consequently, since the '966 patent does not disclose a defined library of available criteria, the '966 patent does not anticipate claim 1 of the present application which claims a "library of available criteria." Since claims 2-4, 7, 10-11 depend on claim 1, they incorporate the library limitation of claim 1, and also are not anticipated by the '966 patent. Similarly, independent claim 12 also recites a library limitation, and is therefore not anticipated by the '966 patent either. Claims 13-15 and 17, which depend on claim 12, are also not anticipated by the '966 patent.

Consequently, the Applicant respectfully submits that the claims are patentable over the '966 patent, and earnestly solicit a notice of allowance to that effect.

§103 Rejection of the Claims

Claims 5-6 were rejected under 35 USC § 103(a) as being unpatentable over Ono et al. The applicant respectfully traverses this rejection.

Claim 5 of the present application recites "computing a tally of the list of items of interest," and claim 6 recites "displaying the tally of the list of items of interest." The Final Office Action admits that the '966 patent does not teach a numerical tally. The Final Office Action goes on to state however that it would have been obvious to a person of ordinary skill to

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
Serial Number: 09/821,504
Filing Date: March 28, 2001
Title: GRAPHICAL USER INTERFACE FOR FILTERING A POPULATION OF OPTIONS

Page 7
Dkt: 2043.199US1

provide an indication of a count, and that the provision of a numeric count is inherent in the presentation of the search results of the '966 patent.

The Applicant respectfully submits that it would not have been obvious to a person of ordinary skill to generate a tally or count, and that the Office Action is using the Applicant's disclosure against the Applicant. It is not true that a numeric count is inherent in the presentation of search results. For to get a numeric count of the search results, an algorithm must be constructed to track this count. Such an algorithm is neither disclosed nor inherent in the '966 patent. Moreover, the purpose of the '966 patent is to retrieve a list of search results, not to count the items in such a list or the items in a database. There is therefore no suggestion in the '966 patent to generate such a count.

The Applicant respectfully submits that claims 5 and 6 are not obvious in light of the '966 patent, and request that the rejection of these claims under 35 USC 103 be withdrawn.

Allowable Subject Matter

The Applicant gratefully acknowledges the allowance of claims 8-9 and 16 over the prior art of record.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
Serial Number: 09/821,504
Filing Date: March 28, 2001
Title: GRAPHICAL USER INTERFACE FOR FILTERING A POPULATION OF OPTIONS

Page 8
Dkt: 2043.199US1

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 612-371-2140 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.
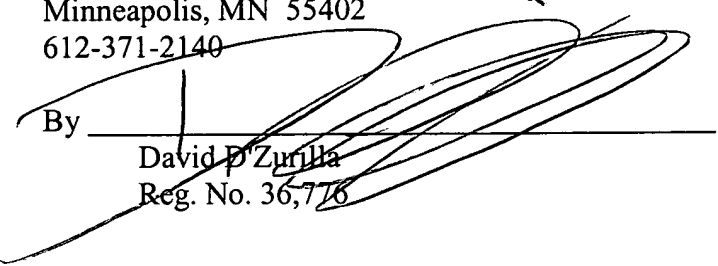
Respectfully submitted,

BRIAN N. SAWYER

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
612-371-2140

Date _____May 19 2005_____   By _____
                                          David P. Zurilla
                                          Reg. No. 36,776

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this _19_ day of May, 2005.

_____Peter Rebaffani_____   _____

Name   Signature